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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,583	10/02/2003	Jean-Christophe Bandini	TUMB-102 CIP 2	2291

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PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
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NEW YORK, NY 10036

EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/678,583

Applicant(s)

BANDINI ET AL.

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/05, 4/05, 10/04, 11/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4 have been examined.

Priority

2. Applicant claimed that the current application is a continuation-in-part of U.S. patent application Ser. No. 09/967,117 which is a continuation of U.S. patent application Ser. No. 09/180,377, entitled "E-MAIL FIREWALL WITH STORED KEY ENCRYPTION/DECRYPTION," Now U.S. Pat. No. 6,609,196 filed Nov. 3, 1998, which is a national stage patent application filed under U.S.C. .sctn.371, based on PCT/US98/15552 entitled "E-MAIL FIREWALL WITH STORED KEY ENCRYPTION/DECRYPTION," filed on Jul. 23, 1998, which claims priority to U.S. Provisional Application No. 60/053,668, entitled "ELECTRONIC MAIL FIREWALL," filed Jul. 24, 1997.

Examiner had reviewed carefully the parent application (09/967,117), now U.S. Patent No. (7,162,738). The parent application (09/967,117) only discloses signature, for example, in col. 7, lines 9-10 and admitted prior art about S/MIME protocol provides digital signature is disclosed in col. 8, lines 12-13. However, the examiner discovered at least three claim limitations, the e-mail relay extracting signature data from the message, the e-mail relay validating the signature data and the e-mail relay executing at least one predetermined action in response to determining that the signature data is valid in the independent claim 1 of the current application are **not supported** by the parent application (09/967,117). Therefore, the examiner will not grant the priory date

Art Unit: 2135

as claimed. The effective filing date of the current application is the filing date of the current application, which is 02 October 2003.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landfield et al. (U.S. Patent No. 5,632,011) and in view of S. Kent, Privacy Enhancement for Internet Electronic Mail, Part II: Certificate-Based Key Management, Network Working Group Request For Comments 1442, February 1993.

As per **claim 1**, Landfield et al. discloses a method for controlling reception of messages in an e-mail network, each message is associated with a message sender, comprising:

providing an e-mail relay ("...proper delivery of smtp e-mail message traffic to the organization" – e.g. col. 1, lines 11-22. Please note to a person with ordinary skill in the art an e-mail relay is an SMTP e-mail server.) the e-mail relay interposed along a message communication path associated with a public network and an e-mail server of the e-mail network (e.g. fig. 1);

the e-mail relay receiving a message intended for a recipient associated with the e-mail network (e.g. col. 4, lines 52-56, step 42 in fig. 2b, steps 52 and 56 in fig. 2c, col. 4, lines 18-20 and col. 4, lines 37-40);

Landfield et al. does not disclose expressly the e-mail relay extracting signature data from the message, the e-mail relay validating the signature data and the e-mail relay executing at least one predetermined action in response to determining that the signature data is valid.

Kent discloses the e-mail relay extracting signature data from the message (e.g. page 4, paragraphs 3-4), the e-mail relay validating the signature data (e.g. page 4,

paragraphs 3-4) and the e-mail relay executing at least one predetermined action in response to determining that the signature data is valid (e.g. page 4, paragraphs 3-4).

Landfield et al. and Kent are analogous art because they are from the same field of e-mail transmission.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate these features of Kent into the method of Landfield et al.

The motivation of doing so would have been "in order to determine that the integrity of its contents have not been modified subsequent", as taught by Kent (page 8, paragraph 1).

As per **claim 2**, the combined teachings of Landfield et al. and Kent disclose a method as applied above in claim 1. Kent further discloses wherein the e-mail relay further classifies the signature data (e.g. page 4, paragraph 2, page 9, paragraph 1 and page 28, paragraph 3 – page 29, paragraph 4).

As per **claim 3**, the combined teachings of Landfield et al. and Kent discloses a method as applied above in claim 1. Kent further discloses wherein the e-mail relay validates the signature data by employing a validation authority (e.g. page 4, paragraphs 1-4).

As per **claim 4**, the combined teachings of Landfield et al. and Kent disclose a method as applied above in claim 1. Kent further discloses wherein said at least one

Art Unit: 2135

predetermined action comprises allowing the message to proceed to at least one recipient (e.g. page 4, paragraphs 3-4).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)

Contact Information

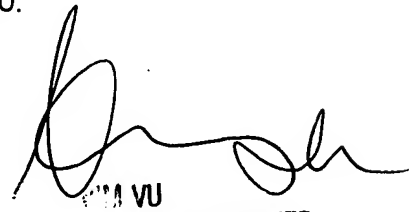
Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11 January 2007
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PATENT EXAMINER
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